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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,023	12/08/2000	Andrea Michalik	2384-002133	4154

7590

11/24/2004

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EXAMINER

HAAS, WENDY C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,023

Applicant(s)

MICHALIK, ANDREA

Examiner

Wendy C Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 and 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet

Continuation of Attachment(s) 6). Other: Requirement for Information 37 CFR 1.105.

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DETAILED ACTION

35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the statutory basis for a rejection that may be made at a later date in response to this Examiner's

Requirement for Information:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by CPVO Breeder's Right grant number **7048** in view of applicant's admission of October 2, 2003 that the claimed plant was first offered for sale March 1, 1999, for reasons of record.

CONCLUSION

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

COMMENTS

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Applicant argues in response to the prior Office Action that the references cited are non-enabling publications and there is no information of record regarding the foreign availability or reproducibility of the claimed plant.

The Examiner believes the cited references are enabling publications under the decision in Elsner, as the CAFC held that "published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public . . . they are proper § 102(b) anticipatory references that may bar patentability." In re Elsner, 381 F.3d 1125, 1129 (Fed. Cir. 2004).

The attached Requirement for Information Under 37 CFR 1.105 is made to obtain more information regarding the foreign availability of the claimed plant, although the Examiner believes applicant's admission of October 2, 2003 is sufficient in this regard.

The claimed plant must be reproducible to qualify for statutory protection under 35 U.S.C. § 161. In the instant case, applicant states in the specification "the variety was first asexually reproduced by cuttings." A person of ordinary skill in the art would know how to

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reproduce a geranium by cuttings. If applicant's invention requires special skill to asexually reproduce, applicant must disclose that information as part of the § 112 best mode requirement.

FUTURE CORRESPONDENCE

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571)-272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

KENT BELL
PRIMARY EXAMINER

Kent Bell

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ATTACHMENT
REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicants and/or the assignee(s) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when the claimed plant variety, 'Penlava', was publicly available prior to the filing date of the instant application. In applicant's Response Under 37 CFR 1.105 (dated October 2, 2003) applicant states "the claimed variety was first publicly available in Germany on March 1, 1999." This response does not identify the accessibility of the publicly available plant.

In response to this requirement please respond to the following interrogatories and/or provide the following documents:

(1) For each instance of public availability or sale of the claimed plant anywhere in the world occurring prior to August 13, 2000, please provide the date the plant was sold or made available, the location where the plant was sold or made available, the name person or entity who sold or transferred possession of the plant, the name of the person or entity who purchased or received possession of the plant as well as any written proof of the sale or transfer, including facsimiles, archived internet records and/or e-mail communications.

(2) Applicant may limit the response to five (5) instances of sale or transfer of the claimed plant occurring prior to August 13, 2000, if necessary.

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The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicants' first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicants are reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicants do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.